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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,508	05/10/2001	Roland Cherif Cherif Cheikh	BET01/0233	2278

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YOUNG & THOMPSON
745 SOUTH 23RD STREET 2ND FLOOR
ARLINGTON, VA 22202

EXAMINER

DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,508

Applicant(s)

CHERIF CHEIKH ET AL.

Examiner

Matthew F DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-47 and 49-89 is/are pending in the application.
- 4a) Of the above claim(s) 56, 58-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 45, 88 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. The examiner is unclear with the wording of claim 45, as how the support or casing forms a peripheral shell surrounding an external surface of the element and forming a reservoir external of said element. The examiner is unclear how a reservoir would be formed external to said element, and if there would be two reservoirs being formed? The examiner cannot visualize what the applicant is claiming and therefore the claim is unclear and indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 45, 46, 47, 49, 50, 52, 87, 88 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamashita (55-7352).

Yamashita discloses a syringe with a reservoir, a piston, a base, needle, and wherein the needle is fastened to the reservoir by direct application of the element forming the reservoir against the base, without the interposition of a seal, by a support or casing which houses said element forming the reservoir. (Figures 1, 4 and 5 and entire reference).

As to claim 45, wherein said element forming the reservoir provides mechanical resistance of the syringe. (Figures 1, 4, 5 and entire reference).

6. Claims 45, 46, 49, 50, 87-89 are rejected under 35 U.S.C. 102(b) as being anticipated by Threlfall (USPN 368627).

Yamashita discloses a syringe with a reservoir, a piston, a base, needle, and wherein the needle is fastened to the reservoir by direct application of the element forming the reservoir against the base, without the interposition of a seal, by a support or casing which houses said element forming the reservoir. (Figures 1, 2 and entire reference).

7. Claims 45 -47, 49, 50, 57 and 87-89 rejected under 35 U.S.C. 102(e) as being anticipated by Higashikawa (USPN 5704918).

Higashikawa discloses syringe with a reservoir, a piston, a base, needle, and wherein the needle is fastened to the reservoir by direct application of the element forming the reservoir against the base, without the interposition of a seal, by a support or casing which houses said element forming the reservoir. (Figures 6, 7, 10, 11, 12, 13, and entire reference)

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8. Claims 45-47, 49, 50, 51, 52, and 87-89 rejected under 35 U.S.C. 102(e) as being anticipated by Park (USPN 6475193).

Park discloses a syringe with a reservoir, a piston, a base, needle, and wherein the needle is fastened to the reservoir by direct application of the element forming the reservoir against the base, without the interposition of a seal, by a support or casing which houses said element forming the reservoir. (Figures 2, 3, 4, 5, and entire reference)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 45-47, 49-55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita as applied to claims 45 – 50, 52 above, and further in view of Higashikawa.

With regard to claims 45-47, 49 – 55, Yamashita meets the claim limitations as described above but fails to include the claimed dimensions. At the time of the invention, it would have been obvious to construct the device from the claimed dimensions since the Federal Circuit has held, where the only difference between the prior art and the claims was a recitation of relative dimension/size/proportion of the claimed device and a device having the claimed relative dimensions would not perform

differently that the prior art device, the claimed device was not patentably distinct from the prior art device.

With regard to claim 57;

Yamashita disclosed the claimed invention but fails to disclose wherein the tubular reservoir has more than two tubes.


Higashikawa disclosed an adjustable dispensing syringe with an outer cast, and two inner tubes that form inside the reservoir.

At the time of the invention it would have been obvious for a person of ordinary skill in the art to combine the disclosed invention of Yamshita with the teachings of Higashikawa because it is well known in the art to use two tubes when combining different agents being injected into the body, especially when one agent is a liquid and the other agent is a solid material.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 1-703-872-9302 for regular communications and 1-703-872-9303 for After Final communications.


Matthew DeSanto
Art Unit 3763
June 16, 2003


BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700